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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,498	07/31/2001	Haruo Togashi	450106-02874	4795

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EXAMINER	
DUNN, MISHAWN N	

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/890,498	TOGASHI ET AL.	
	Examiner	Art Unit	
	Mishawn N. Dunn	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 July 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5,9 and 10* is/are rejected.

7)☒ Claim(s) *3,4 and 6-8* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 July 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. Figures 1A-1E should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of copending Application No. 09/890497. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are substantially the same as that of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Application claims 1 and 2, respectively, recite all as recited in copending application claims 1-3, but the copending application claims further recited a "tape shaped record medium," therefore are deemed narrower than the application claims. While the claims in '498 are not identical to the claims in '497, the scope of the '498 claims are encompassed by the '497 claims, and could have been submitted in that application. Hence, the obviousness double patenting rejection is deemed appropriate.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims1, 2, 5, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneyama (US Pat. No. 5,701,386) in view of Kosugi (US Pat. No. 6,426,771).

3. Consider claim 1. Yoneyama teaches a recording apparatus for compression-encoding a digital video signal (col. 3, lines 9-12; fig. 1), generating a bit stream having a hierarchical structure composed of a plurality of hierarchical levels (col. 4, lines 13-14, fig. 2B), and recording the bit stream to a record medium (col. 4, lines 20-21) comprising: adding means for adding a header of the highest hierarchical level to the bit stream of each frame (col. 3, lines 28-33; fig. 2B); and recording means for recording the bit stream to which the header of the highest hierarchical level has been added to the record medium (col. 4, lines 20-21).

Yoneyama does not disclose an encoding means for intra-frame encoding all the digital video signal. However, Kosugi teaches encoding means for intraframe encoding all the digital video signal so as to compress the digital video signal (col. 3, lines 53-55; fig. 1). An artisan with ordinary skill in the art would readily recognize that before MPEG, a variety of JPEG methods were used to create consecutive frames. JPEG does not use interframe coding between frames and is easy to edit, but not as highly compressed as MPEG. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yoneyama by utilizing JPEG compression to intraframe encode the entire digital signal in order to provide enhanced quality.

4. Consider claim 2. Yoneama teaches an interpolating means for interpolating the header of the highest hierarchical level (col. 3, lines 28-33; fig. 2B).

5. Consider claim 5. Yoneyama teaches a recording apparatus for compression-encoding a digital video signal (col. 3, lines 9-12; fig. 1), generating a bit stream having a hierarchical structure composed of a plurality of hierarchical levels (col. 4, lines 13-14, fig. 2B), and recording the bit stream to a record medium (col. 4, lines 20-21), comprising: adding means for adding a quantizing matrix to the bit stream of each frame (col. 3, lines 28-33; fig. 2B); and recording means for recording the bit stream to which the quantizing matrix has been added to the record medium (col. 3, lines 28-29).

Yoneyama does not disclose an encoding means for intra-frame encoding all the digital video signal. However, Kosugi teaches encoding means for intraframe encoding all the digital video signal so as to compress the digital video signal (col. 3, lines 53-55; fig. 1). An artisan with ordinary skill in the art would readily recognize that before MPEG, a variety of JPEG methods were used to create consecutive frames. JPEG does not use interframe coding between frames and is easy to edit, but not as highly compressed as MPEG. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yoneyama by utilizing JPEG compression to intraframe encode the entire digital signal in order to provide enhanced quality.

6. Method claims 9 and 10 are rejected using similar reasoning as the corresponding apparatus claims above.

Allowable Subject Matter

10. Claims 3, 4, and 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mishawn N. Dunn whose telephone number is 571-272-7635. The examiner can normally be reached on Monday - Friday 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James J. Groody
Supervisory Patent Examiner
Art Unit ~~262~~ 2616